

#16/Pat
PTA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

HOGENKAMP *et al.*

Appl. No. 09/814,123

Filed: March 22, 2001

For: Aryl Substituted Pyrazoles,
Triazoles and Tetrazoles, and the Use
Thereof

Confirmation No. 2060

Art Unit: 1626

Examiner: Shameem, G.

Atty. Docket: 1861.1270001/JMC/THN

**Request for Reconsideration of Patent Term Adjustment
Under 37 C.F.R. § 1.705**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Mail Stop Issue Fee

Sir:

Pursuant to 37 C.F.R. § 1.705(b), Applicants provide a concise statement of facts involved, as well as payment of fees set forth in 37 C.F.R. § 1.18(e).

Statement of the Facts:

Applicants hereby request that the Patent Term Adjustment for the captioned application to be corrected to allow an addition of 78 days.

The U.S. Patent and Trademark Office (PTO) mailed a Notice of Allowance and Fee(s) Due on March 13, 2003. This Notice contained a determination of Patent Term Adjustment under 35 U.S.C. § 154(b), which incorrectly indicated that the Patent Term Adjustment to the date of the Notice of Allowance and Fee(s) Due was zero (0) days.

On September 13, 2001, the PTO mailed a non-final rejection. Applicants timely filed, within three months from the date of the Office Action, an Amendment and Reply on December 13, 2001, *via* hand carry, along with an Information Disclosure Statement. A copy of a date-stamped return postcard evidencing that the Amendment and Reply, and the Information Disclosure Statement were filed on December 13, 2001, is attached as Exhibit A.

On April 18, 2002, the Examiner contacted the undersigned to request information on whether the application will be abandoned because no reply has been filed. The Examiner was notified by a voice mail on the same date that an Amendment and Reply had been filed *via* hand carry to him on December 13, 2001, and the Examiner was requested to inform if the Amendment can not be found and a copy of the Amendment should be submitted.

The Examiner was contacted on May 9, 2002, to confirm whether a copy of the Amendment should be submitted. The Examiner requested a copy of the whole filing of December 13, 2001, excluding copies the references cited in the Form PTO-1449. A copy of a Facsimile Cover Sheet along with a copy of confirmation evidencing that a copy of the filing of December 13, 2001, as described above, was submitted to the Examiner *via* facsimile on May 9, 2002, are attached as Exhibit B.

To date, the information recorded in the PTO's Patent Application Information Retrieval (PAIR) system incorrectly indicates that a response after a non-final action was filed on May 9, 2002, instead of December 13, 2001, and that a delay of 147 days has been caused by the Applicants. Further, the PAIR system incorrectly indicates that a total of two (2) Information Disclosure Statements were filed on December 18 and December 19, 2001. It appears that the Amendment and Reply was incorrectly recorded as an Information Disclosure Statement. In addition, both of the dates December 18 and December 19, 2001 are incorrect and should be December 13, 2001.

On July 1, 2002, a restriction requirement was issued for the above-captioned application.

In view of above, Applicants are entitled to a patent term adjustment of 78 days (from April 14, 2002 to July 1, 2002). 37 C.F.R. § 1.703(a)(2).

The patent issuing from the above captioned application will not be subject to a terminal disclaimer. 37 C.F.R. § 1.705(b)(2)(iii).

In addition, there were no circumstances during the prosecution of the application that constitute a failure to engage in reasonable efforts to conclude processing or examination of the application as set forth in 37 C.F.R. § 1.704(c). On February 14, 2002, Applicants timely submitted a Supplemental Amendment and Reply *expressly requested* by the Examiner on February 4, 2003. This submission does not reduce the period of adjustment set forth in 37 C.F.R. § 1.703. 37 C.F.R. § 1.704(c)(8).

Further, on May 27, 2003, Applicants timely submitted an Amendment Under 37 C.F.R. § 1.312 *expressly requested* by the Examiner *via* telephone conversation on May 22, 2003. Specifically, the Examiner told that the publication branch had requested that Fig. 1 on page 20 of the specification be deleted and, *in lieu* thereof, inserted at the end of the specification. Further, the Examiner requested that a new paragraph be added in the application, entitled "Brief Description of the Drawings". It should be noted that 37 C.F.R. § 1.704(c) provides exemplary circumstances suggesting when Applicant is not engaging in reasonable efforts to conclude processing or examination. The circumstances listed in 37 C.F.R. § 1.704(c) are not exhaustive or limiting. Submission of an amendment under 37 C.F.R. § 1.312 suggests that an applicant is not engaging in reasonable efforts to conclude processing or examination because the Examiner has allowed the application and the applicant presumptively is attempting to continue prosecution via the amendment. Argumentatively, such "actions or inactions prevent or interfere with the Office's ability to process or examine an application." See Response to Comment No. 17, 65 Fed. Reg. 56,379 (September 18, 2000).

However, the facts of the instant matter are different. As explained above, the Examiner expressly requested the aforesaid Amendment. Applicants timely responded to the Examiner's request by amending the specification and drawings so that the patent application could be published and a patent could issue on time. Any contrary "action or inaction" on part of Applicants would have "prevented or interfered with the Office's ability to process or examine the application", and more importantly, delayed the future issuance of the patent. Therefore, Applicants respectfully submit that the aforesaid Amendment has the practical effects of advancing patent prosecution and cannot reasonably be interpreted as a circumstance of failing to engage in reasonable efforts to conclude processing or examination. To interpret Applicants' conduct otherwise would directly contradict the scope and intent of enacting 37 C.F.R. § 704(c) and 35 U.S.C. § 154(b)(2)(C)(i). See Response to Comment No. 17, 65 Fed. Reg. 56,379 (September 18, 2000).

In accordance with 37 C.F.R. § 1.705(b)(1), the fee set forth in 37 C.F.R. § 1.18(e) is provided in our accompanying Credit Card Payment Form PTO-2038. It is not believed that additional fees are required beyond those that may otherwise be provided in documents accompanying this paper. However, if additional fees are

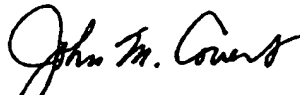
required, the U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

If it is believed, for any reason, that personal communication will expedite consideration of this Request, please do not hesitate to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Request is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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Due Date: December 13, 2001

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When receipt stamp is placed hereon, the USPTO acknowledges receipt of the following documents:

1. SKGF Cover Letter (*in duplicate*);
2. Fee Transmittal Form (PTO/SB/17) (*in duplicate*);
3. Amendment and Reply Under 37 C.F.R. § 1.111;
4. Information Disclosure Statement (*in duplicate*);
5. Form PTO-1449 (16 sheets);
6. Copies of seventy-one (71) cited documents;
7. Our Check No. 33531 in the amount of \$420.00 to cover the following fees: \$72.00 Claims in excess of twenty (37 C.F.R. § 1.16(c)); \$168.00 Independent claims in excess of three (37 C.F.R. § 1.16(b)); \$180.00 Submission of an Information Disclosure Statement (37 C.F.R. § 1.17(p)); and
8. One (1) return postcard.

December 13, 2001

Via Hand Carry
Group Art Unit 1626
Examiner G. Shameem

RECEIVED
TECH CENTER 1600/2900
01 DEC 13 PM 3:30

Please Date Stamp And Return To Our Office